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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Klaus Abraham-Fuchs

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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

EXAMINER

MORAN, MARJORIE A

ART UNIT

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1631

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/784,720	Applicant(s) ABRAHAM-FUCHS ET AL.	
	Examiner Marjorie Moran	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration..
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of the new grounds of rejection set forth below, the finality of the previous office action is withdrawn and prosecution on the merits of the pending claims is hereby reopened. The amendment filed 4/7/07 has been entered. Claims 2-8 and 10-18 are pending. It is noted that some rejections are necessitated by the latest amendment, but some are the result of a series of amendments wherein dependent claims were not amended to "match" newly recited limitations in amended independent claims. The examiner regrets any confusion and inconvenience to applicant.

The rejections made under 35 USC 103 are hereby withdrawn in view of the amendment and arguments filed 4/7/07.

Claim Objections

Claims 2-8 and 10-16 are objected to because of the following informalities: dependent claims should begin with the term --The-- instead of "A" or "An". In claim 14, the term "protocol" in line 2 should be --protocols--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The previous rejections made under 35 USC 112 are hereby withdrawn in view of the amendment filed 4/10/07.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1631

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 4 and 6 each recites "said expert evaluation system" in lines 1-2 which lacks antecedent basis in the claims. Parent claim 17 recites an expert system and an evaluation system as separate limitations, but nowhere recites an "expert evaluation system." As it is unclear whether claims 2 and 4 are intended to further limit the expert system or the evaluation system, the claims are indefinite.

Claim 2 recites "said modified expert rule" in line 2 which lacks antecedent basis. Parent claim 17 recites a network FOR creating a modified expert rule in its preamble, but nowhere recites a "modified expert rule" in the body of the claim. As the antecedent basis for the phrase is unclear, claim 2 is indefinite.

Claim 6 recites "said measurement protocol" in line 2 which lacks clear antecedent basis in the claims. Parent claim 5 recites a "plurality of measurement protocols" in line 2 and "a selected measurement protocol" in line 4. It is unclear if one of the plurality or the selected protocol is intended to be the antecedent for "said measurement protocol," therefore claim 6 is indefinite.

Claim 10 recites "said step of creating a modified expert rule" in lines 1-2 which lacks antecedent basis in the claims. Parent claim 18 recites a method FOR creating a modified expert rule in the preamble, but no longer recited any step of actually creating

a modified expert rule. As parent claim 18 does not recite a step of creating a modified expert rule, the antecedent basis for the phrase is unclear, and claim 10 is indefinite.

Claims 11 and 12 each recite "the step of creating a modified rule" in lines 1-2 which lacks antecedent basis. Parent claim 10 refers to a modified *expert* rule, but nowhere do any of the parent claims recite "a modified rule" which is not an expert rule. Further, no parent claims recites an actual step of creating a modified rule or a modified expert rule. For these reasons, the antecedent basis for the phrase is unclear, and claims 11 and 12 are indefinite.

Claim 13 limits the method of claim 10 to comprise storing a plurality of measurement protocols in memory. It is unclear if this step is intended to replace one or more, or all, of the steps recited in parent claims 18 and 10, or is intended to be an additional step, therefore claim 13 is indefinite. It is noted that additional steps may be so designated by reciting inserting "further" before "comprising in line 1.

Claim 17 recites a network "for creating a modified diagnostic expert rule" in the preamble, then recites a series of limitation including an "expert rule" but nowhere recites a step or other limitation which actually creates or results in a "modified diagnostic expert rule." It is unclear whether the network does indeed achieve the intended result recited in the preamble, therefore claim 17 is indefinite.

Claim 18 recites a method "for creating a modified diagnostic expert rule" in the preamble, and recites a step of "using" an expert rule that identified a medical condition; however, claim 18 fails to recite any step of actually creating a modified diagnostic

Art Unit: 1631

expert rule. It is unclear whether the method does indeed achieve the "intended result " recited in the preamble, therefore claim 18 is indefinite.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie Moran whose telephone number is 571-272-0720. The examiner can normally be reached on M-F 6:30 am- 2 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marjorie Moran
Primary Examiner
Art Unit 1631

Marjorie A. Moran
5/7/07